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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,203	10/17/2003	Jarmo Kuusinen	NOKM.079PA	6660

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EXAMINER

JUNTIMA, NITTAYA

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,203

Applicant(s)

KUUSINEN ET AL.

Examiner

Nittaya Juntima

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3, 5, 6, 27, 28, 30-33, 42 and 45 is/are ~~withdrawn from consideration~~ ^{Cancelled}.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 7-26, 29, 34-41, 43, 44 and 46-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the Amendment After Final filed on 12/5/2005.
2. The objection to the claims are withdrawn in view of applicant's amendment.
3. Claims 2-3, 5-6, 27-28, 30-33, 42, and 45 were cancelled.
4. Applicant's arguments with respect to improper reference, i.e. Soininen et al. (US 2004/0252674 A1), under 35 U.S.C §103(c) have been fully considered and are persuasive. Therefore, the previous Final rejection dated 10/4/2005 has been withdrawn. A new Final rejection is made in view of a new reference Soininen et al. (WO 03/003767 A1) which qualifies as a prior art under section 102(a).
5. Accordingly, claims 1, 4, 7-26, 29, 34-41, 43-44, and 46-49 are rejected under 35 U.S.C. 103(a) based on the newly cited reference.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4, 7-15, 18, 21-26, 29, 34-36, 39-41 and 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soininen et al. ("Soininen") (WO 03/003767 A1) in view of Ejzak (US 2003/0026245 A1), and further in view of "SDP: Session Description Protocol" by Handley et al. ("Handley").

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Regarding claim 1, as shown in Fig. 6, Soininen teaches a method for providing services via a packet-switched multimedia network (PS in Fig. 1) to users (Ann's terminal 90 and Bob's terminal 91) communicating in a circuit-switched domain (CS in Fig. 1), comprising:

Establishing a dialog (SIP dialog as shown in Fig. 6) between a plurality of terminals (Ann's terminal 90 and Bob's terminal 91) using a Session Initiation Protocol (SIP) through the PS multimedia network (PS in Fig. 1). See page 9, third paragraph – page 10, second paragraph.

Providing at least one service (IP application session 92 such as whiteboard session in Fig. 3, page 7, second paragraph) to at least one of the terminals via the dialog. See page 9, first and second paragraphs.

Communicating CS bearer information between the plurality of terminals via the dialog by way of Session Description Protocol (SDP) messages ("The INVITE message contains SIP parameters indicating that a CS bearer should be used and indicates the MSISDN of A's terminal," paragraph 0041, and "OK message including the MSISDN of terminal B... will enable terminal A to call that MSISDN to set up the impending CS call", page 10, first paragraph, therefore, it is inherent that SIP INVITE and SIP OK messages contain SDP messages).

Indicating the CS bearer information, wherein the CS bearer information includes at least an indication that a communication flow is requested via a CS network ("SIP parameters indicating that a CS bearer should be used") and a caller line identifier (MSISDN of the respective terminal) associated with terminals sending the SDP messages. See page 9, fourth paragraph – page 10, first paragraph.

Parsing the SDP messages in terminals receiving the SDP messages to determine the

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CS bearer information (since “The CS call is then established...,” page 10, first paragraph, SDP messages contained in SIP messages must be parsed and processed).

Effecting the communication flow between the plurality of terminals via the CS network as directed by the CS bearer information (“The CS call is then established...,” page 10, first paragraph).

However, Soininen does not explicitly teach (i) an IMS and (ii) SDP extensions as recited in the claim.

(i) Regarding the IMS, Ejzak teaches an IMS having CSCF (Fig. 1, and paragraphs 0021, 0027-0028). Because Soininen further teaches that the same procedure (see the rejection of claim 1) can be used if CSCFs are involved, page 10, third paragraph, and given the teaching of Ejzak on IMS having CSCF, it would have been obvious to one skilled in the art at the time the invention was made to modify the teaching of Soininen to incorporate the IMS as recited in the claim. The motivation/suggestion would have been to utilize the method when CSCFs are used as suggested by Soininen and to provide IP multimedia features and services using the SIP as the primary vehicle for call control as taught by Ejzak (paragraph 0004).

(ii) Regarding the SDP extensions, Handely teaches SDP extensions (“The ‘attribute’ mechanism... is the primary means for extending SDP and tailoring it to particular applications or media... others may be added on an application-, media- or session-specific basis,” page 8). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined teaching of Soininen and Ejzak to include the SDP extensions of Handely such that SDP messages with SDP extensions indicating the CS bearer information

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would be included as recited in the claim. The motivation/suggestion to do so would have been to tailor the SDP to particular application, e.g. CS application, as taught by Handley (page 8).

Regarding claim 4, Soininen teaches wherein establishing a dialog using SIP comprises sending a SIP INVITE message from a first (Ann's terminal 90) of the plurality of terminals (90 and 91) to a second (Bob's terminal 91) of the plurality of terminals, and wherein communicating CS bearer information (SIP parameters indicating that a CS bearer should be used and MSISDN of terminal 90) comprises communicating the CS bearer information by way of a session description (SDP) provided via a message body of the SIP INVITE message (SIP INVITE must include SDP message, page 9, fourth paragraph).

Regarding claims 7, 9, and 12, although Soininen teaches communicating the CS bearer information by way of SDP messages comprise communicating at least some of the CS bearer information particular to communication flows via the CS network (SIP INVITE and SIP OK must include SDP messages, page 9, fourth paragraph – page 10, first paragraph), Soininen does not teach a media type, a sub-field of a media type, and a sub-field of an application media type as recited in the claims.

However, Handely teaches a media type/a sub-field of a media type/a sub-field of an application media type in an SDP which may be extended as new communication modalities emerge (page 19).

Given the teaching of Handley, it would have been obvious to one skilled in the art at the time the invention was made to modify the teaching of Soininen to include a media type/a sub-field of a media type/a sub-field of an application media type such that at least some of the CS bearer information would be communicated via a media type/a sub-field of a media type/a sub-

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field of an application media type particular to communication flows via the CS network as recited in the claims. The motivation/suggestion to do so would have been to enable the media type to be extended to cover new communication, e.g. circuit bearer connection, as taught by Handley (page 19), since such modification of an SDP message format and contents only involves routine skill in the art.

Regarding claims 8, 10, and 13, although Soininen teaches communicating the CS bearer information by way of SDP messages further comprises communicating at least some of the CS bearer information particular to communication flows via the CS network (SIP INVITE and SIP OK must include SDP messages, page 9, fourth paragraph – page 10, first paragraph), Soininen fails to explicitly teach an SDP connection data field identifying the CS network as recited in the claims.

However, Handley teaches an SDP connection data field (page 12) with one additional “c=” field per media description (page 12).

Given the teaching of Handley, it would have been obvious to one skilled in the art at the time the invention was made to modify the teaching of Soininen to include the SDP connection data field such that at least some of the CS bearer information via an SDP connection data field identifying the CS network would be communicated. The suggestion/motivation to do so would have been to utilize the per-media values to override the session-level settings for the relevant media as taught by Handley (page 12) and such modification of an SDP message format and contents only involves routine skill in the art.

Regarding claims 11, 14, and 15, although Soininen teaches communicating the CS bearer information by way of SDP messages further comprises communicating at least some of

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the CS bearer information particular to communication flows via the CS network (SIP INVITE and SIP OK must include SDP messages, page 9, fourth paragraph – page 10, first paragraph), Soininen fails to teach an SDP attribute/a session-level attribute indicative of a type of the communication flow to be effected via the CS network as recited in the claims.

Handley, however, teaches an SDP attribute which additional fields may be added to convey additional information that is specific to an application, a media, or a session (pages 8 and 19)

Given the teaching of Handley, it would have been obvious to one skilled in the art at the time the invention was made to modify the teaching of Soininen to include the SDP attribute which additional fields such that communicating at least some of the CS bearer information via an SDP attribute/a session-level attribute indicative of a type of the communication flow to be effected via the CS network would be included. The motivation/suggestion to do so would have been to convey additional information that is specific to a session, e.g. usage of circuit connection, as taught by Hanley (page 8), since such modification of an SDP message format and contents only involves routine skill in the art.

Regarding claim 18, Soininen teaches communicating the CS bearer information by way of a session description definition (CS parameters and MSISDN must be inherently included in a SDP message of a SIP message) provided via the SIP dialog (Fig. 6 and page 9, fourth paragraph – page 10, first paragraph).

Regarding claims 21-25, Soininen teaches providing application sharing service (e.g. whiteboard session, page 7, second paragraph, and page 9, third paragraph), communicating voice call/real-time media (voice call) via the CS network (page 1, second paragraph, and page 9,

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fourth paragraph), and communicating a conversational/streaming quality of service class (voice call which must include a certain quality) flow through the CS network (page 1, second paragraph and page 9, fourth paragraph).

Claim 26 is a method for establishing a CS connection containing similar limitations as method claim 1 and is rejected under the same reason set forth in the rejection of claim 1 with an addition of establishing a connection (see Figs. 1 and 6) via the CS network based at least in part on the CS bearer information provided via the dialog (page 10, second paragraph).

Claim 29 is a terminal claim corresponding to method claim 1, and is therefore rejected under the same reason set forth in the rejection of claim 1 with the addition of a processing system, a first user agent, and a second user agent which must be included in the terminal (90 in Fig. 6) in order to perform the functions as recited in the claim.

Claims 34-36 are terminal claims containing limitation corresponding to methods claims 9, 12, and 15, respectively, and are therefore rejected under the same reason set forth in the rejection of claims 9, 12, and 15, respectively.

Regarding claim 39, Soininen teaches the terminal (90 in Fig. 6) comprises a mobile station wirelessly coupled to the PS multimedia network and CS network via a RAN (4 in Fig. 1).

Claim 40 is a system claim corresponding to method claim 1, and is therefore rejected under the same reason set forth in the rejection of claim 1 with the addition of a receiver terminal (91 in Fig. 6) which must include a receiver terminal processing system, a receiver terminal SIP user agent, and a receiver terminal CS communication user agent, and a sender terminal (90 in Fig. 6) which must include a sender processing system, a sender terminal SIP user agent, and a

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sender terminal CS communication user agent in order to perform the functions as recited in the claim.

Claim 41 is a computer-readable medium having instructions stored thereon which are executable by a computer system claim corresponding to method claim 1, and is therefore rejected under the same reason set forth in the rejection of claim 1.

Claim 46 is computer-readable medium claims corresponding to method claim 7, and is therefore rejected under the same reason set forth in the rejection of claim 7.

Claims 47-49 are computer-readable medium claims containing limitation corresponding to methods claims 9, 12, and 15, respectively, and are therefore rejected under the same reason set forth in the rejection of claims 9, 12, and 15, respectively.

8. Claims 16-17, 19-20, 37-38, and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soininen et al. ("Soininen") (WO 03/003767 A1) in view of Ejzak (US 2003/0026245 A1), and further in view of "SDP: Session Description Protocol" by Handley et al. ("Handley") and Kotzin et al. ("Kotzin") (US 2004/0120505 A1).

Regarding claims 16-17 and 19-20, Soininen teaches communicating the CS bearer information (parameters indicating that a CS bearer should be used and MSISDNs of terminals) using SIP messages (SIP INVITE and SIP OK must include SDP messages, page 9, fourth paragraph- page 10, first paragraph). Soininen fails to teach communicating the CS bearer information by way of a CS-specific content type value associated with a SIP Content-Type header/a CS-specific value associated with a CS-specific SIP header as recited in the claims.

However, in an analogous environment specific to voice alert, Kotzin teaches a SIP header (Fig. 5) having a Content-Type header (511) and ASCII characters (517) that are specific to voice alert (paragraph 0031).

Given the teaching of Kotzin, it would have been obvious to one skilled in the art at the time the invention was made to modify the teaching of Soininen to include the Content-Type SIP header such that communicating at least some of the CS bearer information by way of a CS-specific content type value associated with a SIP Content-Type header/a CS-specific value associated with a CS-specific SIP header would be included. The motivation/suggestion to do so would have been to provide a Content-Type SIP header specific to an application, e.g. circuit-switching application, and such modification of a SIP header simply involves routine skill in the art.

Claims 37-38 are terminal claims containing limitation corresponding to methods claims 16 and 17, respectively, and are therefore rejected under the same reason set forth in the rejection of claims 16 and 17, respectively.

Claims 43-44 are computer-readable medium claims corresponding to method claims 16 and 17, respectively, and are therefore rejected under the same reason set forth in the rejection of claims 16 and 17, respectively.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nittaya Juntima whose telephone number is 571-272-3120. The examiner can normally be reached on Monday through Friday, 8:00 A.M - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on 571-272-3139. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nittaya Juntima
January 20, 2006
NJ


RICKY Q. NGO
SUPERVISORY PATENT EXAMINER